
United States Court of Appeals

FOR THE NINTH CIRCUIT

16168

VAN BRODE MILLING Co., INC.,

Appellant,

—VS.—

COX AIR GAUGE SYSTEM, INCORPORATED,

Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF CALIFORNIA, CENTRAL DIVISION

APPELLANT'S REPLY BRIEF

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INTRODUCTION

Although the points made in appellee's brief have for the most part been dealt with in considerable detail in appellant's main brief, there are a number of statements in appellee's brief to which reply must be made because they are incorrect and likely to mislead.

THE PATENT INFRINGEMENT COUNT

Infringement

Appellee relies heavily on the rule that a finding of fact must be accepted by an appellate court unless clearly erroneous and states that there was evidence supporting the

lower court's findings herein on infringement. It is submitted that the existence of *some* evidence supporting a finding does not *ipso facto* protect the finding from being held clearly erroneous. Moreover, in the present case as will be pointed out hereinafter the matter of infringement was not solely an issue of fact but was also one of law.

Generally, the issue of infringement centered about the meaning of the phrase "Buna S having a high styrene content." Appellant's proof was to the effect that the phrase refers to actually manufactured butadiene-styrene copolymers having a styrene content substantially greater than the 25% present in standard GRS. Appellee tried to construe the phrase to mean Buna S's with styrene contents of more than 50%.

I.

Literal Infringement.

Regarding the issue of literal infringement, appellee in its brief attempts to discredit the testimony of appellant's expert, Mr. Miller, relating to the meaning of the phrase "Buna S having a high styrene content," by pointing out that he agreed that Buna S's with styrene contents of 70% and above were Buna S's having a high styrene content. The contention that this admission vitiates Miller's testimony that ordinary "GRS" (25% styrene) is the standard (for determining what is a high and what is a low styrene Buna S) is based on the obviously specious assumption that because a 70% styrene copolymer is a high styrene content Buna S, a 40% or 50% copolymer must necessarily be a low styrene content Buna S. This "reasoning" assumes the very point which is in controversy, i.e., what is the standard.

Appellee also insists that the fact that Miller admitted that there were no GRS's above 50% styrene is a discrep-

ancy in his testimony and that in any event he was only stating an opinion based on what was known to persons skilled in the art. As to the first of these points, the fact that the Government did not authorize any synthetic rubbers with a styrene content of more than 50% does not change the simple fact that all of the GRS's were Buna S's. The failure to make GRS's or Buna S's with higher styrene contents than 50% during the period of Government control is hardly a reason for saying that all of the Buna S's made during the period of control were low styrene content Buna S's. Indeed, it would seem that the opposite is the case—i.e. some were high, some low, and some standard, in styrene content.

That Miller gave as his opinion what he believed to be the standard as understood by those skilled in the art is hardly a point in appellee's favor, this being exactly what an expert is supposed to do and what appellee's own expert purportedly did. Moreover, Miller supported his testimony with relevant publications.

The reason why the Court clearly erred in accepting the testimony of appellee's expert is that said testimony not only was contradicted by the very properties of the substances involved but was based on a purely arithmetic and artificial conception of what is high and what is low. His standard was wholly unrelated to the problems involved in the patent in suit. See appellant's main brief, pages 39-41, 66-67.

II.

Infringement by Equivalents.

Coming now to the question of infringement by equivalents, appellee's brief shows a misapprehension of what the doctrine of equivalents stands for. Appellant argued in its main brief that the claim in suit was literally infringed because the dividing line for low and high styrene Buna S's is 25%; however, quite apart from this, appellant argued further that infringement should still have been found on the basis of equivalents. Appellant is not at all arguing that a hold-down frame made of polystyrene modified by *any* Buna S is covered by claim 3. *Appellant does urge that plastic frames made of polystyrene modified by a Buna S having a low styrene content (by appellee's standard) are equivalent to the patented frames when such frames have all of the characteristics set forth and required by the suit patent specification and claims for the patentee's purposes.*

And significantly, it is not just *any* modified polystyrene or modifying copolymer that is involved as far as appellee's frames are concerned. The modifying copolymer employed has a much higher styrene content than standard GRS (25% styrene) and is only *eight* percentage points less than the arbitrary dividing line set up by appellee's own expert and accepted by the lower court. Still further, said expert unequivocally conceded the equivalency of appellee's plastic and the frames made therefrom to the plastic and frames set forth in the patent. On this posture of the evidence, equivalents should have been held as a matter of law, so the rule against reversing a finding of fact unless clearly erroneous does not even apply to the question of equivalents in this case.

Appellee contends that there was a file wrapper estoppel against the granting of an equivalent. It may be noted that

the trial court did not rely on this. File wrapper estoppel applies where a patentee deliberately narrows his claim in order to avoid a prior art rejection, and it operates to prevent him from recapturing something he had surrendered. The particular modifying copolymer and modified polystyrene under consideration herein did not even exist at the time the application for the suit patent was filed. The limitation relating to Buna S having a high styrene content was solely to conform the claims to the disclosure and not in order to avoid prior art.

III.

The Inventor's Testimony.

Appellee by an exercise in semantics seeks to justify the great emphasis placed by the trial court on the inventor's *guess* as to the meaning of the phrase "Buna S having a high styrene content." The argument runs that Coleman was not asked to explain the invention, he was only asked to explain a very important part of it. This is no more cogent than is the lower court's reliance on his uneducated guess. The case of *Helene Curtis Industries v. Sales Affiliates*, 233 F. 2d 148 (C. A. 2, 1956) cited by appellee is not at all in point. In that case a highly technical chemical patent was being construed, and in support of the contention of validity thereof the proponent of the patent itself maintained that certain limitations therein were *critical*. There was a great conflict of evidence on this important issue. The case was one in which minute differences in quantities of ingredients made a great difference as to criticality. That a difference of opinion between the inventor, *who himself was an expert in the field*, and the patent expert was considered by the Court in that case is hardly authority for the position taken by the trial court in this case.

IV.

The Purported Efforts of Appellee's Suppliers to Avoid Infringement.

Appellee also argues that its suppliers, Kravex and Gary, deliberately selected a non-infringing plastic. Just how they selected such a plastic without knowing what was in it either by finding out from the manufacturer, Bakelite, or by analyzing the plastic itself, appellee fails to show. The purported intention of appellee's suppliers not to infringe is, of course, in any case irrelevant. However, it is worth again noting, now that this matter has been adverted to by appellee, that its suppliers by their own testimony could not possibly have known whether the material they allegedly selected infringed or not, and made no effort to find out until *after* this suit was brought. The Court will recall that these suppliers developed the infringing frames both with the aid of the patent and a sample of appellant's frames.

VALIDITY

I.

The File History and Claims.

Appellee makes the rather peculiar claim that the suit patent is invalid because "diagonal clamping members" which originally were present in all of the claims in the application as filed were omitted from claims 3 and 4 of the patent as issued. There is, of course, no rule in the Patent Office or elsewhere that an applicant cannot remove an unnecessary limitation from his claims during prosecution of the application. Appellee has cited no such rule. Accordingly, the fact that the patentee broadened his claims in the mechanical aspect while he was limiting them from

the point of view of the plastic in accordance with the requirements of the Board of Appeals in the Patent Office is not a factor militating against the validity of the patent.

In addition to the foregoing, appellee's contention that no structure for the frame is given in claim 3 as now written is simply absurd. As pointed out in appellant's main brief, the claim in suit sets forth all of the mechanical limitations for a battery hold-down frame and then defines the frame further in terms of its plastic composition and the physical and mechanical properties imparted to it thereby.

Carrying its argument on this matter to an extreme, appellee urges that the absence of the inorganic filler from claim 3 would render the same invalid. Appellee disregards the obvious fact that the specification refers to a copolymer "*such as 'Darex copolymer No. 3.'*" * Surely, the Board of Appeals in requiring that the specification and claims be narrowed down to the type of plastic disclosed did not intend that the patentee could only obtain protection for plastic battery hold-down frames made of the *exact* plastic set forth as an example, especially since there was no prior art requiring such a holding.

II.

Presumption of Validity and the Board of Appeals Decision.

Coming now to the presumption of validity, appellee argues that the Examiner approved the claims without regard to the decision of the Board of Appeals and without making a further search of the plastic arts. Appellant submits that the Examiner clearly followed the mandate of the Board of Appeals. He was not under appellee's

* Plaintiff's Exhibit 1, column 2, lines 54-55.

necessity of dissecting and torturing the Board's opinion in order to exonerate an unconscionable infringement. He took the language for what it meant and allowed the claims when they were limited as required by the Board.

Both appellee and the trial court have not apprehended the essential meaning of the decision by the Board of Appeals. The Board, although affirming the Examiner's holding rejecting the original claims, completely nullified the Examiner's contention that the Leuvelink patent which disclosed a plastic clamp for electron tubes could by combination with patents for plain metal frames be held to show that the instant inventor's idea of making a *plastic battery hold-down frame of a particular and appropriate type of material* was not inventive.* The reason for this decision was that Leuvelink's plastic was not at all useful for battery hold-down purposes, and, of course, Leuvelink's clamp was itself an entirely different object employed for entirely different purposes, although it did perform a clamping function. It was because of this holding that the Examiner allowed the claims of the suit patent after amendment.

It is readily seen in view of the above that no further search by the Examiner after the decision by the Board of Appeals was necessary. *Even if the Examiner had found all of the art relied on by appellee at the trial of this case, it would not have changed the result because the most he might have found was the type of plastic suggested by the inventor, and he would not have found such plastic used or even suggested for any purpose analogous to the inventor's.* Thus, under the decision of the Board of Appeals the patent would still have had to be granted. Actually, the Examiner fully obeyed the decision by the Board of Appeals which had pointed out that the inventive concept of a plastic battery hold-down frame made of a par-

* See quotation at page 32 of appellant's main brief.

ticular and appropriate type of plastic was entitled to protection.

The case of *The Hoover Company v. Mitchell Manufacturing Company*, 122 U. S. P. Q. 314 (C. A. 7, 1959), cited by appellee for the proposition that long prosecution of a patent application in the Patent Office may show lack of validity is completely inapplicable here. In that case, the application was prosecuted for *fourteen* years. Moreover, the Court noted that after the patent issued the patentee disclaimed certain claims on the ground that he was not the inventor of the material covered thereby, thus by this action himself discrediting to some extent the actions of the Patent Office.

III.

The Prior Art.

Although appellant argued in its main brief at length the validity of the suit patent over the art cited even on the assumption that Coleman's particular plastic was itself shown to be old thereby, appellee has nevertheless seen fit to discuss this art in some detail. In this discussion, certain erroneous implications and statements are made; these will now be rebutted.

Appellee has simply glossed over the fact that a battery hold-down frame is a specific type of article designed for a particular purpose. The fact that it is an article used in connection with a storage battery does not mean that any other article relating to a battery is the equivalent of a battery hold-down frame. Nevertheless, this absurd contention is what seems to be urged by appellee. There is a constant attempt to strengthen the prior art by implying that because plastic battery cases and covers existed and because other automotive parts were made of plastic, the

invention of the suit patent is shown by this art. This is simply not the case, and the Court is urged to scrutinize the prior art very carefully lest it be misled by loose statements into mistakenly believing that plastic battery hold-down frames of any kind whatsoever were shown in the art.

A very recent case in which the Court upheld validity over prior publications containing general disclosures of materials without suggested application to a particular art is *National Latex Products Company v. The Sun Rubber Company, et al.*, 123 U. S. P. Q. 279 (C. A. 6, Oct. 28, 1959—not otherwise reported). The art relied on in the present case is of the same character as that held insufficient in the *National Latex* case.

Another completely unsubstantiated contention made by appellee is that the development of a plastic battery hold-down frame was a “natural” one and that the invention resulted from the existence of publications in the art disclosing particular types of plastic allegedly suitable though not suggested for such frames. Not only was there not a scintilla of evidence supporting this, but the very fact that nobody made a plastic battery hold-down frame until Coleman made his invention, despite the crying need therefor, clearly refutes this argument. Even further, the type of plastic Coleman used did not become known generally until two years after the invention.

Appellee apparently recognizes the cogency of appellant’s argument and cases cited on substitution of materials, for appellee simply dismisses the cases cited by appellant with the statement that they do not apply because substitution of plastic for steel in making a plastic battery hold-down frame was the result of “the general industrial revolution.” The record will be searched in vain for proof or even suggestion of any such “revolution.” Moreover, the raw materials of which the patented plastic battery hold-down

frames are made were available long before the invention by Coleman of such frames* (see appellant's main brief, p. 51).

IV.

Sufficiency of Disclosure.

As to the attack on the sufficiency of the disclosure, appellee is on the two horns of a dilemma. On the one hand appellee contends that its supplier was able to avoid infringement of the patent by studying the same. How could it have done so if the disclosure was too indefinite to be understood? On the other hand, appellee argues that the prior art relied on clearly shows how to make plastic battery hold-down frames merely because it discloses certain plastics, although the prior art concededly does not even mention plastic hold-down frames. How then can appellee, in the light of these contentions as to infringement and the adequacy of the prior art disclosures, argue that the molding processes, temperatures, etc. had to be included in the patent specification for adequacy of disclosure?

Generally, as pointed out in appellant's main brief (pp. 38-42, 53-56), it was not necessary that the suit patent disclose molding processes, temperatures and so on for the disclosure to be adequate. These were known in the art. The patent disclosure is sufficiently clear for the invention of the patent to be practiced. This is established both by the expert testimony of Mr. Miller and the success of appellee's suppliers in producing a competitive plastic frame a few months after they decided to infringe the patent.

One other matter in this connection remains to be discussed. Appellee contends that the disclosure was deliber-

* The principles relating to substitution of materials were very recently applied, in the *National Latex* case, *supra*.

ately inadequate in order for the patentee to retain certain trade secrets. In purportedly supporting this by reference to the record, appellee conveniently omits citation of page 373 of the Record on Appeal in which the same witness on whose testimony appellee relies, namely, Coleman, states that he does *not* believe that appellant was claiming a trade secret.*

V.

Utility.

Appellee has repeated its contention of lack of utility. Its attempt to support this contention is misleading and relies on a quotation taken out of context. The record showed that a very minute percentage of the original frames broke and was sent back. And the inventor's sensitivity to this as reflected in the quotation in appellee's brief surely is attributable to the fact that he was trying to sell to the trade an entirely new product and would, of course, have preferred that it had been absolutely perfect from the start. The evidence on utility is set forth and discussed in great detail in appellant's opening brief at pages 28-30 (see particularly the footnote on pp. 30-31), and the Court is respectfully referred to these pages for a complete refutation of the claim of lack of utility.

Appellee's attempt to distinguish the cases cited by appellant on this point by contending that appellant's original frames were not *intrinsically* useful has no substance at all. Except for a minor amount of breakage, appellant's original frames were completely useful. Indeed, a new industry resulted from their introduction.

* "Mr. Halle: I didn't ask him about the proportion. I want to know what the company is claiming as a policy, as a trade secret?"

The Witness: I do not believe the company is claiming it as a trade secret" (R. p. 373).

Appellant pointed out in its main brief that partial success was sufficient proof of utility not because of any fears that complete utility had not been established for appellant's original frames but because the trial court misconceived the law on utility and erroneously thought that immediate and unqualified perfection were required.

Finally, appellee urges that because appellant had mixing problems at first, it did not have a commercially acceptable frame until it began using the Bakelite material. As was pointed out in appellant's opening brief (p. 29), appellant switched to the Bakelite material because with it no mixing at all had to be performed and this was much more economical than having someone mix the raw materials for it. In addition, the testimony showed that Dewey and Almy was not the only concern which could successfully mix the raw materials for appellant; on the contrary, the record shows that Stedfast Rubber Company had no trouble at all performing the mixing but that because of Stedfast's location, another company, Marine Plastics, located nearer to appellant, was employed in order to lower production costs by reducing transportation expenses. It was Marine that was not able to satisfactorily mix the polystyrene and modifying copolymer. It should be understood that the problem was not one of proportions of ingredients or any other such matter.

VI.

Commercial Success.

As to commercial success, appellee contends that only 1% of appellant's frames was made with its original plastic and that once the Bakelite material was adopted the frames were no longer made in accordance with the suit patent. Of course, appellant's frames were all made in accordance with the suit patent. The reasons for this are the same as those already set forth in the main brief and previously herein relating to the issue of infringement. In other words, appellant's frames are all made in accordance with the suit patent either on the basis of literally reading on the claims or on the basis of equivalents, just as is the case with appellee's frames.

As to the percentage of frames sold which were made with the original mixture, it should be remembered that appellant was putting on the market a brand new product. Naturally its first sales were small compared to later sales. The amount of frames sold originally is much more significant when considered against the fact that *none* had ever been sold before than when considered against the number of frames sold once the product became popular.

The statement (in appellee's brief) that appellant had to spend \$150,000 in selling its frames also is highly misleading. That figure included appellant's general overhead. Actually, only about \$6,000 in true advertising was spent, certainly a very small amount for a new article.

Generally, the argument that appellant's frames have not been a commercial success is somewhat surprising in view of the fact that concededly they solved a forty-year-old problem and created a new industry. Indeed, the avidity with which appellee's suppliers copied the frames once

they were well established is ample evidence of how successful they were. The fact that automobile manufacturers still use the defective steel frames as original equipment does not change this. The steel frames are much cheaper and, therefore, more suitable for a mass production item such as cars on which every element of expense is weighed very carefully. The impact of the present invention was felt in the automotive trade as far as replacement of the original frames on cars was concerned, and the evidence showed that in this respect it almost completely displaced the old frames.

VII.

Long-Felt Need.

On the question of long-felt need, appellee apparently would do away with the unchallenged testimony of Messrs Ert, Bean and Goldin on the ground that the need for a better battery hold-down frame could not be felt until high impact plastics were developed. The speciousness of this would seem to be self-evident. The need existed regardless of the capacity of the trade to fill it. Moreover, even if Coleman had not been able to provide plastic frames until the necessary materials were available this would be irrelevant on this point. The fact would still remain that he was the first one to solve the problem and fill the need.

Actually, however, the raw materials of which Coleman made his frames had been available for many years before companies like Bakelite came out with the so-called high impact plastics, so that what Coleman did was not merely the result of the presence for the first time of a new material. The evidence showed that Coleman produced a modified polystyrene independently and prior to the time modified polystyrenes of his type first came into existence. Indeed, the term "high impact polystyrene" did not even appear in "Modern Plastics Encyclopaedia" until 1952, two

years after Coleman's invention, so that there can be no question but that on the present record Coleman filled the long-felt need for a plastic battery hold-down frame *before* a material capable of being used for a plastic battery hold-down frame was available or even generally known.

VIII.

The Ditz Patent.

Recognizing that the Ditz patent was not admissible as prior art, appellee attempts to support the receipt in evidence of the patent and reliance thereon by the lower court by stating that the patent was put in evidence only for the purposes of anticipation. The colloquy quoted in appellee's brief in support of this unfortunately does not tell the whole story. On page 295 of the record occurs the following:

"Mr. Caughey: For what purpose, may I ask, is it being offered?"

Mr. Halle: It is being offered for every purpose that I can use it for. As prior art—."

Still further, on page 297 the trial court states clearly that it is receiving the patent to show the status of the art. There can be no question but that the Ditz patent was offered, received and used as prior art.

In addition to the foregoing, it is perfectly obvious that the Ditz patent could not have had any other purpose than that performed by prior art. It is not an anticipation because it does not relate to battery hold-down frames. The law is clear in this Circuit that for a patent to be an anticipation, it must show the invention claimed to be anticipated. Likewise, the patent could not be used under Section 102(e) of Title 35 of the United States Code providing that "*the invention was described, . . .*," since the in-

vention is *not* described in the Ditz patent which discloses a plastic material for battery casings and shoe soles.

Recognizing the foregoing, appellee attempts to argue that because the Ditz patent mentions battery covers, it shows the same invention as the suit patent. This simply is not so, and doubtless, if appellee attempted to run a car with just a cover on the battery and no battery hold-down frame, it would be forced to recognize just how great a difference there is between covers and hold-down frames since the battery would be dislodged at the first bump.

As for appellee's contention that the Ditz patent could properly be used as prior art, this has been fully refuted already in appellant's main brief (pp. 56-60).

THE UNFAIR COMPETITION COUNT

The whole defense to the claim of unfair competition was on the basis that the color and shape of the parties' frames are functional. The difficulty with this defense is that it is entirely unsupported. Indeed, it is hard to conceive how the color of a product which goes under the hood of an automobile can be functional.

Further disregarding the proved facts, including its own proof, appellee urges that no design feature was involved as far as unfair competition is concerned. But there was such a feature, namely, the shape of the frames; and that this shape also was completely non-functional was established by appellee's own exhibit D showing a plastic-covered metal frame which looks nothing at all like the present parties' frames but which, nevertheless, performs the same hold-down function. A plastic frame does not have to have the exact design as that of the patented frames in order to function properly. Yet the parties' frames are to all intents and purposes identical.

The plain fact of the matter is that appellee's suppliers brazenly copied appellant's frames which they had before them as to color, shape and everything else in an effort to trade on appellant's good will and deceive the automotive industry. And it was not a "similar" color that was adopted by these suppliers as stated in appellee's brief but the *same* color.

It is no answer to the foregoing to contend, as appellee does, that the packages for the parties' respective goods serve to prevent confusion or that the ultimate consumer (car owner) may not see the products out of their packages. The persons who are misled and deceived are that section of the public constituting the automotive trade, namely, auto supply stores, gas stations, etc. It was established at the trial without contradiction that the parties' frames are displayed outside of their containers in which condition they would be completely indistinguishable unless one looked closely enough to see the patent marking on appellant's frames. Thus, persons in the automotive trade could certainly be deceived.

Appellee has in no way negated appellant's proof of likelihood of confusion. The fact that Western Auto Company sells appellant's frames under its own trademark in no way affects this. Appellant's patent marking and name occur on all of its frames including those sold through Western Auto, so that it is clear to the automotive trade that whether they buy from appellant or from its customer Western Auto they are getting the same frames.

CONCLUSION

Appellee's brief has in no way met the points made in appellant's main brief. The latter and this reply to appellee's points constitute a complete refutation of appellee's arguments. The judgment below should be reversed.

Respectfully submitted,

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